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TECHNOLOGY CENTER 3600

In re Application of	:	DECISION ON PETITION
BRUNN, Michael	:	TO REVIEW RESTRICTION
Application No. 10/691,404	:	REQUIREMENT UNDER
Filed: October 21, 2003	:	37 CFR 1.144
For: SUPER LONG RANGE CRASH-BANG	:	
ROUND	:	

This is in response to applicant's petition filed under 37 CFR 1.144 received March 1, 2005 requesting a review of the requirement for an election of species made in the Final Office action mailed February 2, 2005 and that the election requirement be withdrawn and previously withdrawn claims be considered.

A review of the record indicates that the examiner required an election of species on April 27, 2004 between the articles shown in Figs. 4A and 4B, Figs. 5A and 5B, Figs. 6A and 6B, and Figs. 7A and 7B. The applicant traversed the restriction, pointing out the supposed errors, and electing the invention of Figs. 4A and 4B on June 1, 2004. In the next Office action, mailed September 13, 2004, the election of species requirement was made final. The examiner withdrew claims 6, 10, 11, 16-19, 21, 30, 32, 33 and 35 as being drawn to the non-elected species of Figs. 5A through 7B, rejected claims 1-5, 7-9, 12, 13, 15, 20, 22-29, 31, 34 and 36-38, and objected to claim 14 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. In the amendment of November 29, 2004, applicant amended claim 1 to include the substantive limitations of claims 13 and 14; thus believing that amended claim 1 is in condition for allowance. Corresponding amendments were also made to independent claims 26 and 27. Applicant also requested that previously withdrawn claims 10, 11, 18, 19, 21, 32, 33 and 35 be reconsider for examination through their dependence on claims 1 and 27. Newly added claims 39-55 were presented in the amendment of November 29, 2004. In the Final Office action mailed February 3, 2005, the examiner also withdrew newly added claims 40, 41, 48, 50, 51 and 53 for consideration as being directed to a non-elected species, since applicant had received an action on the merits for the originally presented invention (i.e., the species of Figs. 4A and 4B). It is at this point in the prosecution that the Office received the above-noted petition.

Applicant argues that there are two criteria for making a proper Restriction Requirement: (a) the inventions must be independent or distinct as claimed; and (b) there must be a serious burden on the examiner to examine the inventions. Applicant traverses the restriction requirement because

the examiner has failed to make a prima facie showing of a serious burden "by appropriate explanation of separate classification, or separate status in the art, or a different field of search" (MPEP § 803.01). Applicant argues that because the Examiner has failed to show any of these, or even to make any statement concerning the serious burden criteria, the examiner has not made a proper Restriction Requirement. In the Office action mailed September 13, 2004, the Examiner stated that there are a plurality of patentably distinct species and that any additional set of species would require additional search. Thus, it would be a burden on the examiner.

Applicant's reliance on MPEP § 803.01 does not apply to a restriction requirement between species. The criteria for a proper restriction with respect to species is whether the inventions are independent (i.e., species under a genus which are not useable as disclosed) and whether they are patentably distinct (MPEP § 806.04(h)). Since the species of Figs. 4A and 4B, 5A and 5B, 6A and 6B, and 7A and 7B are mutually exclusive they are clearly independent. Whether the species are patentably distinct is necessarily a subjective test applied by each examiner given the nature of the art. In this case, it can not be said that the inventions of 4A and 4B, 5A and 5B, 6A and 6B, and 7A and 7B are clearly unpatentable over one another (i.e., clearly obvious variants). Thus the inventions are at least arguably patentably distinct.

Petitioner's allegation that the examiner's burden must be shown via either different classification, status in the art or different field of search is not well founded. MPEP § 808.01(a) states that once different species are established "it is not necessary to show a separate status in the art or separate classification" as it is for other kinds of restriction requirements.

With respect to the examiner's finding that amended claim 1 is not generic to the species recited in claims 10, 11, 18, 19 and 21, applicant's arguments are found to be persuasive. Claim 1, as amended, is generic to the species of Figs. 4A and 4B, 5A and 5B, and 6A and 6B. In all applications where a generic claim is found allowable, the application, in the next Office action, should be treated as indicated in MPEP § 809.02 (b), § 809.02 (c), or § 809.02 (e). MPEP § 809.02 (c) states that when all claims to each of the additional species are embraced by an allowable generic claim as provided by 37 CFR 1.141, applicant must be advised of the allowable generic claim and that claims drawn to the nonelected species are no longer withdrawn since they are fully embraced by the allowed generic claim. Therefore any withdrawn claims dependent upon claims 1, 26 and 27 are no longer withdrawn since they are fully embraced by the allowed generic claim. However, it should be noted that claims 18, 19, 40, 41, 50 and 51 are directed to a species that has not been originally disclosed. Claims 18 and 19, for example, call for a projectile having a container for the at least one material comprising the weighty and frangible ballast (claim 18) wherein the container is comprised of nylon (claim 19). And claims 40 and 41 call for a crash-bang cartridge assembly comprising a weighty and frangible ballast comprising a mixture of zinc powder and graphite powder (claim 1) and a liquid (claim 40) wherein the liquid is methylene (claim 41).

With respect to claims 18 and 19, none of the projectiles of the species of Figs 4A and 4B, 5A and 5B, and 6A and 6B comprise a container. Only the projectile of Figs. 7A and 7B comprises a container wherein the container comprises nylon. Furthermore, the projectile of Figs. 7A and 7B comprises a weighty and frangible ballast comprising a liquid. The specification and the

claims, as originally filed, disclose a crash-bang cartridge comprising a weighty and frangible ballast comprising either a mixture of zinc powder and graphite powder or a liquid such as methylene chloride. The disclosure does not provide support for the ballast as comprising the combination of both the mixture of zinc and graphite powder and a liquid.

SUMMARY: The petition is **GRANTED-IN-PART**.

In view of the findings noted above, the restriction requirement will not be withdrawn. However, the application will be returned to the examiner of record for consideration of all the claims in the application, including the issue of whether or not claims 18, 19, 40, 41, 50 and 51 are supported by the specification, as originally filed.


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